SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. ~~1454~~ 222

JOHN M. SISKO,

Petitioner,

v.

SOUTHERN RESIN & FIBERGLASS CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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SOUTHERN RESIN & FIBERGLASS CORPORATION,

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Petitioner, John M. Sisko, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit, entered in the above-entitled action on March 6, 1967.

CITATION OF OPINIONS BELOW

On December 20, 1965, Judge Mehrtens of the United States District Court for the Southern District of Florida, filed Findings of Fact, Conclusions of Law and Judgment, in the case of John M. Sisko, Plaintiff, v. Southern Resin

& Fiberglass Corporation, Defendant, Civil Action No. 64-465-Civ-WM. (R. 385). This decision was reported at 248 Fed. Supp. 797, 148 U.S.P.Q. 587, and is printed in Appendix C, hereto, *infra*, page App. 13.

On appeal, the decision of the District Court was affirmed by the United States Court of Appeals for the Fifth Circuit, on March 6, 1967, Appeal No. 23471. This decision is reported at 373 F.2d 866, 153 U.S.P.Q. 7, and is printed in Appendix A hereto, *infra*, page App. 1.

JURISDICTION

The judgment of the Court below was entered March 6, 1967. Jurisdiction of this Court is invoked under the provisions of Title 28, United States Code, Section 1254(1).

QUESTION PRESENTED

The issue sought to be presented to this Honorable Court by the present Petition is whether the Petitioner's patent is invalid as being "obvious" under the provisions of Title 35, U.S.C. 103, and whether the Court below, in so ruling, properly applied the provisions of the Statute pursuant to the standards and guidelines laid down by this Court.

More specifically, is the decision of the Court below in direct conflict with the doctrines expounded by this Court in *Graham v. John Deere Co.*, 383 U.S. 1, 15 L. ed. 2d 545, 86 S. Ct. 684 and *United States v. Adams*, 383 U.S. 39, 15 L. ed. 2d 572, 86 S. Ct. 708.

The question presented must be viewed with reference to the following facts clearly established in the record of the present case:

(a) that the invention, although simple in concept, was the first to provide an adequate solution to a long-felt want in the industry, (e.g. R. 33);

(b) that it involved a radical departure from the prior art approaches to the same problem (R. 271-280);

(c) that it was the fruit of a long and difficult period of experimentation by the inventor, a man well versed in the art (R. 283-345);

(d) that it was accorded an immediate acceptance by the industry, as witnessed by the respondent's own survey (PX 43);

(e) that the respondent's supplier, adjudged to be the "basic underlying, defendant" (R. 8), knew of the inventor's struggles but could not suggest a solution (R. 286);

(f) that respondent's supplier, in quick succession, (i) sought exclusive sales rights to the invention (R. 105), (ii) sought to buy out the inventor's company (PX 41; R. 114), (iii) sought to have an alternative product developed and introduced to the market (PX 98, 174) and (iv) finally resorted to the ultimate tribute of developing and manufacturing a direct copy of the invention (PX 168, p. 25);

(g) that both the inventor's product and the infringing product enjoyed immediate commercial success (R.307);

(h) that the infringer has widely and lavishly praised the merits of the invention in its advertising and promotion of the infringing product, i.e. by reporting that it "has been received as the most single greatest advancement in structural core materials for fiberglass boats in the last decade" (PX 140).

Against this background Petitioner submits that the invention *cannot* be considered "obvious", and that such a ruling below must be in error.

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

Jurisdiction for the subject matter of this proceeding ultimately rests upon Article I, Section 8 of the Constitution.

The present action was brought under the provisions of Title 35, U.S.C. 281, but the issue raised in the present Petition is based upon 35 U.S.C. 103, subject to the effect of 35 U.S.C. 282.

The constitutional provision and all three sections of the statute are printed in Appendix B, *infra*, page App. 12.

STATEMENT

Summary of the Proceedings Below

The present case originated in the U.S. District Court for the Southern District of Florida, Miami Division, Civil Action No. 64-465-Civ-WM on a complaint, (R. 336) for infringement of U.S. Letters Patent No. 3,139,371 issued on June 30, 1964 to John M. Sisko, Petitioner herein. Respondent counterclaimed for a ruling of invalidity and non-infringement. Jurisdiction of the District Court, invoked under the provisions of Title 28, United States Code, Section 1338(a), was stipulated (R. 349). By decision dated December 17, 1965, the District Court held the patent invalid on several grounds and not infringed (Appendix C, page App. 13).

The U.S. Court of Appeals for the Fifth Circuit ruled upon only one issue on appeal, holding that the Sisko patent was invalid as constituting merely an obvious improvement over certain prior art patents and practices. (Appendix A, page App. 1).

The Invention

The Sisko patent relates to a novel assembly of material for use as a core in plastic laminates, generally known as "sandwich" constructions. In essence, the novel core

product is formed of balsa wood and comprises a plurality of individual balsa blocks arranged in side-to-side, end-to-end coplanar relation to define a substantially continuous core sheet. The blocks are mounted on a backing sheet of flexible and stretchable material that is characterized by a plurality of uniformly spaced openings therethrough in the nature of a mesh. This backing is disposed entirely across one face of the sheet of balsa blocks and is secured independently to each block, as by an adhesive, at points spaced inwardly from the outer edges of the respective blocks (Appendix D, page App. 29; R. 16).

The invention was specifically developed for use in the construction of laminated fiberglass boat hulls. In practice, an outer layer of wet fiberglass resin is laid in the mold and then the patented core sheet is draped into place, becoming embedded in the inner surface of the resin. Immediately thereafter, a second layer of wet resin is applied over the core sheet to form the inner "skin" of the laminate. As in conventional fiberglass construction, each skin normally incorporates fiberglass mat or other material of this type, but this has no significance insofar as the present invention is concerned (R. 21-24).

The principle advantage of this lamination is that the balsa core material is relatively light in weight and yet it adds very significantly to the structural stability of the hulls. This renders the hull a great deal more rigid and thereby eliminates the necessity for supplementary stingers and other framing means. In addition, it adds to the buoyancy and the shock-absorbing characteristics of the hull and it provides an economical way to increase the overall thickness of the hull. The final product is much more solid in all respects than a simple fiberglass shell.

Functionally, the major improvement derived from Sisko's invention was that his core material was "drapable". The individual blocks "float" independently and conform themselves readily to the *compound* curvatures usually encountered in hull designs. For example, in the area of the prow,

the hull normally curves outwardly about a longitudinal axis and at the same time it curves upwardly about an axis transverse thereto. The balsa core constructions employed to a limited extent in the prior art were incapable of being disposed in such a curvature.

Furthermore, the Sisko invention provided for the first time a means whereby balsa wood could be formed into a laminated hull without requiring the intervening step of physically holding the core in place while the outer skin of the laminate was permitted to set. This enabled a relatively continuous process and saved valuable mold time. The molds had previously been tied up while the first layer of resin set, usually for an overnight period.

The History of the Art

The boat building industry had long recognized the desirability of laminated fiberglass construction. For many years the Respondent's supplier, Balsa Ecuador Lumber Company, had proposed a system involving random lengths of balsa slats placed by hand, piece by piece, into the outer layer of resin and embedded therein in a longitudinally staggered pattern resembling that of a brick wall (R. 21, 251-253). Heavy weights or other devices were required to hold these slats in position until the underlying layer of resin had set. Then the weights were removed and the second layer of resin was applied. This was a time-consuming, manual operation and had the built-in delay factor necessarily incident to the requirement of setting the first layer of resin. While the system was used commercially to a limited extent, there is no evidence that it enjoyed any significant commercial success. Nevertheless, this is the system which must be looked to as the conventional prior art in the field of balsa cores for fiberglass boat hulls.

The record shows one alternative construction that was introduced into the field in 1959 (R. 229-234; R. 153-183) and it is this construction which has been referred to by the Court below as the prior art practices of Nortex and

Edwards. Specifically, the construction involved a plurality of elongated balsa strips, here again arranged in a longitudinally staggered brick-wall type of pattern but this time preassembled to a fabric backing. The characteristic which is most significant is that the assembly was heavily coated with a resin so that it formed a relatively rigid board, as opposed to the drapable sheet of the present invention (R. 271-277). This board was positioned in the outer layer of resin, being bent or broken where necessary to adapt it to the configuration of the hull (R. 280). As in the earlier prior art it was held in position by weights or the like until the outer layer of resin had cured, again involving delays (R. 230, 251, 252).

The only advantage which might have been gained by this system was that the balsa slats were preassembled, but the process remained cumbersome and time-consuming, and there is no evidence of significant commercial use. Furthermore, it involved an added danger of tending to entrap air in the laminate which causes a very serious structural defect in the finished product (R. 280). In fact, the only two companies which are known to have adopted this system both went out of business (R. 279).

It should be noted that a number of other core materials such as styrofoam were also tried unsuccessfully by the fiberglass boat industry (R. 33).

Prior Art Patents

The only other prior art disclosures relied upon by the Court below were the patent to Cunninghame, 972,574, issued in 1910, and the patent to Ams 476,934, issued in 1892. Both of these patents are drawn from the non-analogous field of decorative coverings for walls or the like. Thus, they are concerned with *surface* constructions rather than *sandwich* constructions. Their elements are decorative tile pieces rather than buoyant structural members. They are in both instances primarily intended for flat installations; in the case of Ams, mention is made of rolling the material

up but there is certainly no suggestion of contouring in both directions simultaneously, as would be necessary in adapting to compound curves. There is no suggestion in either of the patents as to the use of a stretchable backing as required in the claimed invention to permit the floating of the block elements when adapting to compound curves. Indeed, Cunninghame employs a non-porous backing which would be totally unsuitable because resin could not flow freely through it.

The prior art patents are thus different in purpose and different in construction. The fact that they clearly do not meet the terms of the Sisko patent is indicated by the decision of the Court below in choosing to rule on the basis of obviousness under 35 U.S.C. 103 rather than on the basis of anticipation under 35 U.S.C. 102(a). Indeed, the novelty of the claimed combination is quite apparent from the record, and respondent's expert witness below admitted that neither the Ams nor the Cunninghame construction would serve the purposes intended here (R. 254, 257).

It should be noted that the same type of prior art patents had been considered and rejected by the Patent Office while the Sisko application was under examination. Accordingly, there should be a presumption under 35 U.S.C. 282 that the claims are valid over the same teachings in the Cunninghame and Ams patents (*Otto v. Koppers Company*, 246 F.2d 789, (C.A. 4, 1957).

Sisko Invention Not Suggested by Broadly Similar Teachings from Patents in Non-Analogous Art

The present case is a classic illustration of the dangers involved in trying to transfer isolated teachings from one art in an effort to establish that a somewhat comparable arrangement in another art is obvious. (*Potts v. Creager*, 155 U.S. 597, 39 L. ed. 275 (Sup. Ct., 1895), *A. J. Deer Co. v. U.S. Slicing Machine Co.*, 21 F.2d 812 (C.A. 7, 1927). It is impossible to believe that the people who were searching for

a suitable balsa core material prior to Sisko's invention were not thoroughly familiar with conventional bathroom tiles. These are assembled in exactly the same manner as the Cunninghame and Ams constructions—and yet the "obviousness" of Sisko's solution did not become apparent to these people.

When the Sisko invention is viewed in proper perspective, its true merit must be recognized. The facts here are quite different from what was involved in the case of *Graham v. John Deere, supra,* where the patented invention merely involved a minor improvement in the construction details of the inventor's prior device. Here Sisko has developed a construction that was *entirely* new to the art. There had *never* been a unitary flexible core material. Sisko's product performed in an entirely different manner to attain results never before possible. Rather than merely improving the function of some prior construction, he clearly turned a failure into a success. To this extent it is truly a pioneer invention.

As in the case of *United States v. Adams, supra,* Sisko was working against a background of failure. His own experimentation and the approaches of the prior art had tended to lead away from his invention rather than to it.

The Sisko Invention Was Not "Obvious"

Viewed in the abstract, the Sisko invention might appear to be quite obvious because it is relatively simple in nature. However, this characteristic should not be charged against it. Simplicity is often cited as one of the attributes of a great invention. Consider the utter simplicity of the leakproof battery in the case of *Goodyear v. Ray-O-Vac Company,* 321 U.S. 275, 88 L. ed. 721 (Sup. Ct., 1944).

Any holding of obviousness must necessarily involve the improper application of hindsight.

> "Knowledge after the event is always easy and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new things which seemed to have eluded the search

> of the world was always ready at hand and easy to be seen by a merely skillful attention." *Diamond Rubber Tire Co. of N.Y. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 435, 31 S. Ct. 444, 447, 55 L. Ed. 527 (1911).
>
> "Now that it has succeeded, it may seem very plain to anyone that he could have done it as well. This is often the case with inventions of the greatest merit." *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 446; 2 S. Ct. 698, 715; 46 L. Ed. 968 (1902), citing *Webster Loom Co. v. Higgins*, 105 U.S. 580, 26 L. Ed. 177.

Decision Below Acknowledged Evidence of Non-Obviousness

The Court of Appeals has acknowledged the existence of certain of the criteria of non-obviousness which have been cited hereinabove in defining the Question Presented.

> "The record contains considerable evidence showing the need for the product of the patent, and the commercial success of the product. The evidence also discloses that the manufacturer of the accused product sought a sales agreement under the patent in suit and sought also to purchase appellant's business prior to developing "Contourkore." This conduct, of course, buttresses appellant's contention of novelty and utility, and it likewise supports the idea of need for the product."

The record is very strong on these points and they should have been properly evaluated in ruling on the question of obviousness. (*Graham v. John Deere Co., supra; Goodyear v. Ray-O-Vac Company, supra; and Bryan v. Sid W. Richardson, Inc.*, 245 F.2d 191 (C.A. 5, 1958)

Perhaps the greatest deficiency in the ruling of the Court below is its failure to recognize the significance of the pattern of infringement. The record shows that the Respondent's supplier is one of the leading producers of balsa wood in the world and admittedly the largest supplier of balsa

wood to the boat building industry (PX 33). Obviously, this company had the expertise and the wherewithal to find any "obvious" solution long before Sisko arrived on the scene. The record shows that it was actively interested in doing so (e.g., R. 249), and yet there is no explanation as to why Sisko's allegedly obvious solution had eluded the infringer for more than twenty years.

There is a flagrant contradiction between, on the one hand, the defense that the invention is obvious, and on the other hand, the tenacious actions leading to infringement, as outlined in the "Question Presented" hereinabove. As stated by Judge Medina in rejecting a defense based on obviousness

> "This is the familiar talk of an infringer, and it comes with the less grace from an infringer who has paid the device the most sincere of all compliments by copying it root and branch." *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 261 (C.A. 2, 1959)

The fact that Respondent's supplier could not develop a competing product of its own and would infringe rather than resort to the prior art constructions must lend strong corroboration to Petitioner's position on non-obviousness. (*Colgate-Palmolive v. Carter Products*, 230 F.2d 855 (C.A. 4, 1960).

The efforts to acquire rights to the invention must indicate the importance which the infringer attributed to Sisko's invention. (*Metals Disintegrating Co. v. Reynolds Metal Co.*, 130 F.S. 227 (D.C., Del. 1955))

The advertising and promotion of the infringing product bear still further witness to the significance of the invention, *Potts v. Creager, supra,* and *Sel-O-Rak v. Henry*, 232 F.2d 176 (C.A. 5, 1956).

REASONS FOR GRANTING THE WRIT

(1) The writ should be granted to correct the failure of the Court below in applying the tests of non-obviousness

expounded in *Graham v. John Deere Co., supra,* and *United States v. Adams, supra.* In these cases, the Supreme Court expressly intended to establish guidelines for determining the question of obviousness. Once having done so, the Court should review a case such as the present one, which would appear to have seriously misinterpreted or ignored the guidelines handed down.

It is important that the Supreme Court's standards for determining obviousness be used as true tests by the lower courts rather than merely as supporting arguments to be embraced only when they happen to support the abstract judgment of the court on a question of obviousness.

(2) The doctrine of obviousness warrants further elucidation by this Court. The entire patent system depends upon the proper application of this doctrine. Where determinations are left to abstract judgment, there are major inconsistencies and uncertainties on the part of patent counsel, patent examiners and the courts. This Court has properly recognized the necessity for providing guidance in this area, and the *Graham* and *Adams* decisions cited above have materially reduced the inherent difficulties. Nevertheless, a further pronouncement by this Court, as by applying its doctrines to the present set of facts, would be most helpful in promoting a uniformity of decisions among the courts.

(3) The Petitioner, John M. Sisko, is entitled to have justice done in the premises. This is his court of last resort.

After a long and arduous experimentation, entailing a great deal of time and sacrifice, he developed a product which responds to the needs of the industry. With further efforts, and considerable risk on his part, he started from a capitalization of $600 and, without outside assistance, he was successful in introducing his product to the market. He established a small but growing business.

The patent system properly protects the highly technical inventions which evolve in ever increasing numbers from the laboratories of major corporations, but it is this type of in-

dividual inventor that the framers of the Constitution had in mind when they provided:

> "The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." (Article I, Sec. 8)

In this case, rather than deriving any of the rewards to which he was justly entitled for his invention, the Petitioner found that it was quickly copied and that he was subjected to the severest type of competition from a source with whom he could not really compete. The Courts below have failed to recognize the validity of his patent rights. A denial of relief from this Court would be tantamount to the elimination of the Petitioner's business from competition and a deliverance of his invention to the infringer. The possibility of such a result would be unthinkable, and calls upon this Court to exercise its powers of supervision.

CONCLUSION

For the reasons set forth herein, Petitioner urges that a writ of certiorari should be issued.

Respectfully submitted,

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APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

October Term, 1966

No. 23471

D. C. Docket No. 64-465-WM-Civil

JOHN M. SISKO,

Appellant,

versus

SOUTHERN RESIN & FIBERGLASS CORPORATION,

Appellee.

Appeal from the United States District Court for the Southern District of Florida.

Before BROWN, BELL and AINSWORTH, Circuit Judges.

JUDGMENT

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Florida, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, affirmed.

It is further ordered and adjudged that the appellant, John M. Sisko, be condemned to pay the costs of this cause in this

Court for which execution may be issued out of the said District Court.

March 6, 1967

Issued as Mandate: MAR 28 1967

IN THE

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 23471

JOHN M. SISKO,

Appellant,

versus

SOUTHERN RESIN & FIBERGLASS CORPORATION,

Appellee.

Appeal from the United States District Court for the Southern District of Florida.

(March 6, 1967.)

Before BROWN, BELL, and AINSWORTH, Circuit Judges.

BELL, Circuit Judge: This appeal by the plaintiff below is from a judgment holding all six claims of United States Letters Patent No. 3,139,371 invalid and not infringed by defendant-appellee. The District Court sustained the asserted defenses of invalidity

based on an absence of novelty over the prior art, invalidity in that the claimed invention was obvious to persons having ordinary skill in the art, and invalidity by reason of the product of the patent having been sold and used commercially more than a year prior to the filing date of the patent. The court also concluded that there was no infringement. Findings of fact and conclusions of law were entered with respect to each of the defenses. We affirm on the ground of obviousness. For that reason it is unnecessary to reach the other assignments of error. *Cf. J. R. Clark Company v. Murray Metal Products Company*, 5 Cir., 1955, 219 F.2d 313 on the appropriateness of this procedure.[1]

The patent in suit is entitled "Core Block Construction." It is an improvement patent in the field of core materials. It was granted on June 30, 1964 to appellant Sisko on an application filed May 24, 1963. The patent involves a construction material for use in forming laminated boat hulls.[2] It consists of a

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1 The District Court followed the salutary practice of determining the validity of the patent before going to the question of infringement. *Sinclair & Carroll Co., Inc. v. Interchemical Corporation*, 1945, 325 U.S. 327, 65 S.Ct. 1143, 89 L.Ed. 1644; *Up-Right, Inc. v. Safway Products, Inc.*, 5 Cir., 1963, 315 F.2d 23. The case, coming to us for review as it does on a record which includes findings and conclusions on both validity and infringement, is ripe for final disposition even in the event of reversal on validity. This posture reflects good judicial husbandry.

2 Claim 1—"A construction material for use in forming laminated boat hulls and the like, comprising: a plurality of core blocks arranged in side-to-side, end-to-end coplanar relation to define a substantially continuous core sheet; a sheet of flexible and stretchable material covering one face only of said core sheet and being provided throughout its entire extent with a plurality of uniformly distributed

plurality of balsa core blocks, preferably three inches long and three inches wide, arranged in side-to-side, end-to-end coplanar relation to form a core sheet. These blocks are attached to a flexible and stretchable backing material, preferably a nylon hexagonal mesh, by means of a spot adhesive. The backing material is bonded to each block by glue spaced inwardly from the edges of the blocks in order to facilitate the relative movement of the individual blocks with respect to one another. The gluing and spacing of the blocks when combined with the stretchable backing material permits the sheet to be incorporated into a flat laminate or one of single or compound curvature, ideal for the construction of boat hulls.

The file wrapper indicates that the patent application was rejected by the Patent Office until the

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openings therethrough; and connecting means securing said sheet of flexible material to one face only of said core sheet, said connecting means attaching the sheet of flexible material to the adjacent surface of the individual core blocks at points spaced inwardly with respect to the side edges of said surfaces, the other surfaces of the respective core blocks remaining unconnected to permit a floating movement of said core blocks with respect to said sheet of flexible material and to thereby enable said core sheet to conform against a surface of compound curvature disposed outwardly of said other face thereof."

Claim 2—"A material as defined in claim 1 wherein said connecting means comprises a spot adhesive."

Claim 3—"A material as defined in claim 1 wherein said flexible material comprises a lightweight nylon mesh of hexagonal configuration capable of being stretched in any direction."

Claim 4—"A material as defined in claim 1 wherein said core blocks are formed of balsa, each being on the order of three inches in length and width and on the order of from one-half inch to one inch in depth."

Claim 5 and 6—Directed to incorporating the product of claim 1 in laminated boat hulls.

claims were limited to two critical features. One of these called for using a stretchable backing material for the blocks. The other called for the backing material to be attached to the blocks by a spot adhesive placed at points inwardly from the edges of the blocks.

Appellee is the distributor of the accused product, "Contourkore." This product was manufactured by Balsa Development Corporation, a subsidiary of the Balsa Ecuador Lumber Corporation of New York, and had been made in two forms. The product made prior to September 1964 was composed of a layer of balsa wood blocks held together by a fiberglass backing, spot glued to one surface of the blocks inwardly from the edges of the blocks. The product made after September 1964 was similarly composed, but the fiberglass fabric was secured to the balsa blocks by glue lines extending completely across the face of the blocks.

The defense of noninfringement was based on two features which were claimed as distinguishing the accused "Contourkore" from the patent in suit: a different backing material, and the manner in which the blocks were bonded to this material. These were said to avoid the two critical features which gave the Sisko claims patentability. First, in the Sisko patent the backing material, nylon mesh, was stretchable. In the "Contourkore" product, the fiberglass backing was non-stretchable according to the findings. This takes on added significance in light of appellant's

admission that his experiments with fiberglass were unsuccessful. Secondly, the blocks in the product of the patent are bonded by a spot adhesive spaced inwardly from the edges of the blocks. It is not clear that appellee's bonding system prior to 1964 was different. After September 1964 appellant's practice was to use glue lines extending completely across the face of the blocks. Sisko urged that this was relatively unimportant in any event as the adhesive pulled loose from the blocks when the sheet was curved with the result of matching the method of the Sisko patent.

The record contains considerable evidence showing the need for the product of the patent, and the commercial success of the product. The evidence also discloses that the manufacturer of the accused product sought a sales agreement under the patent in suit and sought also to purchase appellant's business prior to developing "Contourkore." This conduct, of course, buttresses appellant's contention of novelty and utility, and it likewise supports the idea of need for the product.

The Supreme Court had occasion to consider the question of obviousness with respect to the validity of a patent in a recent case. *Graham v. John Deere Co.*, 1966, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545. The court construed the language of 35 USCA, § 103, as meaning that a patent may not be obtained, although the invention has not been identically disclosed in the prior art, when the differences between the subject matter for which the patent is claimed and the prior

art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. We followed this decision in *Up-Right, Inc. v. Safway Products, Inc.*, 5 Cir., 1966, 364 F.2d 580.[3] There we approved a finding of invalidity based on obviousness, and pointed out that patentability depends not only on novelty and utility, but also on nonobviousness.

Thus we come to the question of obviousness or nonobviousness for appellant must first cross that statutory hurdle. Moreover, our path, as was true in *Graham v. John Deere Co.*, is to decide that question, which is a phase of the legal question of validity, on the result of factual inquiries. These inquiries are to be directed to the scope and content of the prior art and practices, the differences between the prior art and practices and the claims at issue, and the level of ordinary skill in the art involved.

We begin with the problem which was to make a construction core in the form of sheets out of balsa blocks for use in the laminated boat hull industry. It was necessary for the sheets to have the characteristic of drapability so as to fit the desired contours of the hulls. Compound curves were a part of the problem.

Some of the prior art cited by the Patent Office, Muller, No. 2,556,884; Winnick, No. 2,562,976; and MacDonald No. 2,653,358, in granting the patent in suit is, beyond question, pertinent. However, two patents, not considered by the Patent Office in granting

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[3] This was the second appearance of that case in this court. See 315 F.2d 23, supra, for the first appearance.

the patent, were found by the District Court to be more pertinent.[4] We agree. The first of these is the Cunninghame patent, No. 972,754, issued in 1910. It involved a decorative mosaic structure consisting of a series of small square units or blocks glued to a backing sheet of thin pliable material. The blocks were fastened to the backing so that they were entirely independent of one another, allowing them to be flexed in any direction and applied to any curvilinear surface. The District Court found that this patent described the same combination of the same three elements; i.e., blocks, a flexible backing sheet, and the gluing of the blocks to the sheet in such a manner as to make them independent of each other and capable of being flexed in any direction; and that they were capable of performing the same function as the product of the Sisko patent.

The second was the Ams patent, No. 476,354, issued in 1892. It described a material for use as a facing for ceilings, floors, partitions and the like. The facing was to consist of tile blocks placed side by side on an open mesh flexible backing sheet, such as wire netting, to which the tiles were individually fastened

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[4] By reason of the failure of the Patent Office to cite this and the Ams patent, No. 476,354, the District Court concluded that the patent in suit was entitled to no statutory presumption of validity under 35 USCA, § 282. This conclusion is assigned as error but we do not reach that question in the view we take of the case. Even assuming a presumption, it would not overcome the obviousness which appears from the sum of the record, and the invalidity which follows therefrom. On the strength of the presumption under such circumstances, see *Cornell v. Adams Engineering Company*, 5 Cir., 1958, 258 F.2d 874; *Murray Company of Texas, Inc. v. Continental Gin Co.*, 5 Cir., 1959, 264 F.2d 65.

by cement. The cement as applied was set back from the edges of the blocks. In this way the netting was exposed between the joints allowing the facing to be rolled up. The backing sheet of the Ams patent was described as flexible.

With respect to the use of the balsa blocks in boat hull construction, there was evidence of the use of balsa strips as a core material in laminated boat hulls prior to the patent filing date. This practice was known to Sisko. The Edwards Boat Company of Lumberton, North Carolina, and Nor-Tex Manufacturing Co. of Dennison, Texas, in 1959 and 1960, employed balsa wood core strips or slats laid out in sheets or carpet forms of the desired contour, non-flexible, and held in place by a backing material to which one surface of the balsa was glued with a polyester resin. The balsa slats were in such lengths as would conform to the desired contour. These hull manufacturers made their own sheets after purchasing the balsa. The controversy here is over the new practice of prefabricating the sheets of balsa in flexible form for sale to the hull manufacturers. Both parties are so engaged.

It would appear that the differences between the claims of the Sisko patent, on the one hand, and these prior art patents and practices, on the other, involved only a choice of material, balsa blocks over other types of material; structural details such as sizes of the blocks; and the use of a stretchable backing, nylon, rather than cloth or wire. Spot gluing as well as the use of backing on a group of blocks

was old in the art. Flexibility to accomplish drapability in the area of curves was also old. A stretchable backing would merely facilitate the desired flexibility. Anyone skilled in the laminated plastic boat field would be aware of the need for a drapable core material to conform to the contour of a boat hull. It would be apparent that drapability could be accomplished by the use of a flexible backing on blocks and the spacing of the blocks on the backing so as to permit their movement. It would also be apparent that the smaller the blocks, the more readily they would conform to a curved surface. Edwards and Nor-Tex had employed the core material principle of using balsa slats or blocks laid out in a sheet or carpet of the desired contour. Appellant improved the process by providing blocks in flexible sheets so as to more readily conform to the varying contours, but Cunninghame and Ams taught this procedure long before.

We conclude, based on the test set out in *Graham v. John Deere Co., supra,* that the facts of record amply support the findings and conclusion of the District Court that the patent in suit is invalid because of obviousness. The improvement which it teaches is the work of a skillful mechanic but does not rise to the level of an invention.

AFFIRMED.

Adm. Office. U. S. Courts—E. S. Upton Printing Co., N. O., La.

APPENDIX B

Constitutional and Statutory Provisions

Constitution of the United States, Article 1

> Section 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writing and discoveries.

35 U.S.C., Sec. 281. *Remedy for infringement of patent*

> A patentee shall have remedy by civil action for infringement of his patent.

35 U.S.C., Sec. 282. *Presumption of Validity;*

> A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

35 U.S.C., Sec. 103. *Conditions for patentability; non-obviousness subject matter*

> A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

APPENDIX C

IN THE
UNITED STATES DISTRICT COURT
For the Southern District of Florida

No. 64-465-Civ-WM.

JOHN M. SISKO,
Plaintiff,

vs.

SOUTHERN RESIN & FIBERGLASS CORPORATION,
Defendant.

FINDINGS OF FACT, CONCLUSIONS OF LAW

This cause having come on for trial before the Court, sitting without a jury, on November 22 and 23, 1965, during which witnesses were heard, exhibits and depositions were received in evidence and considered, and briefs of both parties having been submitted and considered, the Court hereby makes the following findings of fact and conclusions of law.

Findings of Fact.

1. John M. Sisko, plaintiff, is a resident of the State of Florida and his address is 6463 Manor Lane, South Miami, Florida. Southern Resin & Fiberglass Corporation, defendant, is a Florida corporation. There is no dispute as to jurisdiction of venue.

2. The complaint charges defendant with infringement of Sisko patent 3,139,371 (which issued to plaintiff June 30, 1964 on an application filed by plaintiff May 24, 1963. Patent 3,139,371 (hereinafter referred to as the Sisko patent) has been owned by plaintiff since the issuance thereof. Defendant has denied infringement and alleges the patent in suit to be invalid on various grounds. Defendant has also counterclaimed for a declaratory judgment of invalidity and non-infringement on the same grounds.

3. The Sisko patent is a narrow improvement patent in the field of core materials and relates to blocks of wood or the like laid side-by-side and end-to-end and held together by an open mesh flexible and stretchable fabric glued to the blocks. The product of the Sisko patent is designed primarily for use as a reinforcement layer in making small plastic boats, but the patent makes it clear that the product can be used for other purposes.

The patent mentions blocks made of balsa wood, styrofoam and other plastics (column 1, lines 57-60), but it is clear from this portion the patent and a statement at column 3, lines 37 to 41, that the blocks may be formed of any other material.

As to dimensions, the patent says (column 1, lines 62-63) they "may vary in accordance with the intended use of the finished product," and (column 3, lines 37-41) may be changed from those described by way of example. Plaintiff's witness Pfuntner admitted that the blocks could be square or rectangular. (Tr. 65.)

4. The Sisko patent has six claims.

Claim 1 of the Sisko patent defines a product called a "construction material" made up of three elements:

(1) a number of "core blocks" arranged side to side and end to end to form a core sheet,

(2) a sheet of "flexible and stretchable material" having distributed openings and covering one face of the core blocks, and

(3) "connecting means" securing the sheet of flexible material to the blocks at points spaced inwardly from the edges of the blocks.

Claim 2 adds to claim 1 the statement that the "connecting means" is a "spot adhesive."

Claim 3 adds to claim 1 the limitation that the flexible material is a nylon hexagonal mesh.

Claim 4 adds to claim 1 the statement that the core blocks are balsa wood blocks about 3″ long and 3″ wide.

Claims 5 and 6 incorporate the core of claim 1 in a plastic hull in the manner commonly done in the prior art.

5. The file wrapper (Defendant's Exhibit 6) of the Sisko patent shows that the claims of the Sisko application were repeatedly rejected by the Patent Office Examiner. (Defendant's Exhibit 6, pp. 16-17, 33-34) In order to obtain the allowance of the claims, all of the claims were limited to two features said to be "critical." These features, which appear in all of the claims of the Sisko patent, are:

(a) the use of a stretchable backing material, and

(b) connection of the backing material to the individual core blocks at points spaced inwardly with respect to the side edges of the blocks.

By introducing these limitations, plaintiff voluntarily abandoned coverage of all products that do not have these "critical distinctions" over the prior art. Exhibit Supply Co. v. Ace Corp., 315 U.S. 126, 136 (1942); I. T. S. Co. v. Essex Co., 272 U.S. 429, 443-4 (1926).

In the amendment of May 8, 1964 plaintiff told the Patent Office (Defendant's Exhibit 6, page 38):

"Two critical distinctions applicant has pointed out involve the use of porous, stretchable material, on the one hand, and the use of connecting means spaced inwardly from the side edges of the blocks, on the other hand. Both of these go directly to the

purpose for which applicant's device is intended, and without these features the device would not be suitable for this purpose."

On the basis of these limitations voluntarily placed in the claims and plaintiff's representations, the Patent Office allowed the claims.

Infringement exists only when the accused device and the teachings of the patent in suit are substantially identical in structure, mode of operation, and results accomplished. Stewart-Warner Corp. v. Lone Star Gas Co. (5 Cir. 1952), 195 F.2d 645. Patents on simple combinations are difficult to obtain. If sustained, they are confined strictly to the particular combination claimed. Such patents are not easily infringed for while in principle the doctrine of equivalence is applicable to them, it is only when most narrowly circumscribed. Hughes Tool Co. v. Magnolia Petroleum Co. (5 Cir. 1937), 88 F.2d 817.

6. Defendant is a distributor of and has sold the accused product, Contourkore. This product has been made in two forms:

(a) The Contourkore product made prior to September, 1964 and sold by defendant was of the type shown in Plaintiff's Exhibit 2.

(b) The Contourkore product made after September, 1964 and sold by defendant was of the type shown in Plaintiff's Exhibit 1.

7. The Contourkore product exemplified by Plaintiff's Exhibit 2 was composed of a layer of balsa wood blocks held together by a fiberglass fabric spot glued to one surface of the blocks. The Contourkore material exemplified by Plaintiff's Exhibit 1 is composed of a layer of balsa wood blocks held together by a fiberglass fabric secured to the balsa blocks by glue lines extending completely across the face of the blocks. The Contourkore material of Plaintiff's Exhibit 1 additionally uses a special acrylic glue that dissolves in the polyester resin employed in a plastic boat construction within a few minutes of being sprayed with the polyester resin (Tr. 328-329).

8. Neither Contourkore product was a copy of the product of plaintiff's patent. Both distinguished from that product and from the patent claims in a vital particular: the Contourkore products (Plaintiff's Exhibits 1 and 2) both used fiberglass fabric for the backing. This fiberglass fabric is not "stretchable" as that term is used in the claims of the Sisko patent. The vital difference between plaintiff's product and defendant's product is especially emphasized when considered in the light of plaintiff's repeated admissions (Tr. 404-5, DX7, pp. 65, 73-4) that his own trials and experiments with fiberglass had been miserable failures.

The Sisko patent (col. 2, lines 1-4) says its nylon mesh is "capable of stretching in any direction," and provides "for a high degree of stretching." Also the patent (col. 2, line 70 to col. 3, line 2) says it is the "stretching characteristics of the mesh" and the spot gluing that enable the core blocks to "float" into proper position. Sisko admitted that spot gluing and

a stretchable fabric in combination were essential (Sisko deposition; Defendant's Exhibit 7, pp. 83-85).

Plaintiff's witness, Pfuntner, admitted that glass fibers per se were not stretchable (Tr. 90), and that the fiberglass mesh was not stretchable in an up-and-down or sideways direction. Pfuntner did say that when the mesh was pulled on the bias, it was stretchable, but this is not what the Sisko patent means by stretchable. Pulling the fabric on the bias does not occur during normal application of Contourkore to a curved plastic shell (Tr. 332).

9. The Contourkore product, as made since September 1964 (Plaintiff's Exhibit 1), has the fiberglass fabric secured to the balsa blocks by glue lines extending completely across the faces of the blocks from edge to edge. These glue lines are not "spaced inwardly with respect to the side edges" of the blocks as required by all of the claims of the Sisko patent. This inward spacing requirement was one of the two "critical distinctions" pointed out to the Patent Office during the prosecution of the Sisko patent application (Defendant's Exhibit 6, p. 38), and cannot now be ignored in interpreting the claims of the Sisko patent.

10. During the period January through April 1962, more than one year prior to the Sisko patent filing date of May 24, 1963, plaintiff sold to Bertram Yacht Company in Miami balsa core materials comprising a plurality of balsa core blocks arranged in side-to-side, end-to-end coplanar relation, a sheet of flexible and stretchable material covering one face only of

the core sheet and being provided throughout its entire extent with a plurality of uniformly distributed openings therethrough, and connecting means (glue) attaching the sheet of flexible material to the adjacent surface of the individual core blocks at points spaced inwardly with respect to the side edges of the adjacent block surfaces, the other surfaces of the core blocks remaining unconnected (Tr. 280-284). This is the product of the Sisko patent.

11. The Bertram purchase orders and plaintiff's invoices (Defendant's Exhibits 8 and 9 and 11 to 20) are admitted to be authentic and accurate and show sales of balsa core materials by plaintiff to Bertram prior to May 24, 1962.

Sisko had difficulty in remembering the construction of the balsa core materials he sold to Bertram in the first four months of 1962, but the testimony of Walters at the trial is conclusive. Walters was a friend of plaintiff (Tr. 253) and was Chief Plastics Design Engineer for Bertram Yacht Company during 1962 (Tr. 254-255) and prior to his deposition had given an affidavit on behalf of plaintiff in support of plaintiff's motion for a preliminary injunction in this case.

It is clear from Walters' testimony, and the Court finds, that at least some of the products sold and delivered by plaintiff to Bertram in the first four months of 1962 were identical to or so nearly like the product claimed in claims 1-4 of the Sisko patent that any differences were immaterial.

It is also clear from Walters' testimony, and the Court finds, that at least some of the cores which

Sisko sold to Bertram prior to May 24, 1962 and which were the same or substantially the same as the product of the Sisko patent were incorporated by Bertram in boats which it was then building (Tr. 284, 287). Thus, Walters admitted that plaintiff's Balcor material, the product of the Sisko patent, was installed in boats by Bertram before May 24, 1962 (Tr. 300).

12. Sisko's testimony at the trial neither contradicted nor explained Walters' plain testimony that Bertram, prior to May 24, 1962, had purchased from plaintiff a substantial number of products, like those of the patent in all material respects, and had used these products in making boats prior to May 24, 1962.

13. These sales were not for an experimental use but were commercial sales primarily for profit and the product was "in public use or on sale in this country more than one year prior to the date of the application for patent" within the purview of 35 U.S.C. §102(b).

A single sale of the patented product for profit is sufficient to invalidate the patent in suit, if it was prior to May 24, 1962. Consolidated Fruit-Jar Co. v. Wright, 94 U.S. 92, 94 (1876); Electric Battery Co. v. Shimadzu, 307 U.S. 5, 20 (1939). The law on this question is discussed thoroughly in the recent case of Piet v. United States, 176 F. Supp. 576, 581-584 (S.D. Cal. 1959), affirmed specifically on this point, 283 F.2d 693 (9 Cir. 1960), and also in the even more recent case of Webber v. Guiberson Corporation, 231 F. Supp. 596, 600 (D.C.S.D. Tex. 1963), aff'd, 336 F.2d 461 (5 Cir. 1964), cert. denied, 379 U.S. 989 (1964).

14. Sisko did not originate the idea of using blocks of balsa wood as a core material in making laminated plastic boats. Nor did he originate the idea of assembling such balsa wood blocks in side-to-side and end-to-end relation, held together by a piece of fabric glued to one surface of them for this end use. This is clear from the testimony of Pfuntner (Tr. 367-371), Lippay (Tr. 311-318), and Defendant's Exhibit 4.

15. Long prior to May 24, 1962, plastic boats had been made with balsa wood as a core material. The Edwards Boat Company of Lumberton, North Carolina, and Nor-Tex Manufacturing Co. of Dennison, Texas, in 1959 and 1960 employed balsa wood core strips or slats laid out in a layer or carpet of the desired contour, and held in place by mesh material glued to one surface of the balsa wood with a polyester resin. The balsa slats or blocks were made sufficiently short to conform to the desired contour (Tr. 191-192, 195, 205-207, 214-224, 311-318). Defendant's Exhibit 4 describes tihs process, and Defendant's witness Lippay testified that he had observed it in operation in the North Carolina area in the period 1959-1960 (Tr. 312-313). Plaintiff's witness Pfuntner admitted that this process was one of the early methods with which he was familiar (Tr. 98-99).

16. Cunninghame patent 972,754 describes a series of small square units or blocks, which may be made of wood (p. 1, lines 75-77), glued to a backing sheet of thin pliable material such as cloth (page 2, lines 41-50). The blocks are glued to the backing so that they are entirely independent of each other, can be flexed in any direction and can be applied "to any curvilinear surface" (page 2, lines 69-84). This pat-

ent describes the same combination of the same three elements capable of performing the same function as the products set forth in claims 1 to 4 of the Sisko patent.

17. Although the Cunninghame patent does not refer to boat hulls as specified in claims 5 and 6 of the Sisko patent, these claims do nothing more than set the core material of claim 1 in an old context, and hence add nothing patentable to claim 1.

18. Ams patent 476,354 describes a material for use as a facing for ceilings, floors, wainscoting, partitions, etc. This facing consists of a layer of tiles placed side by side on an open mesh flexible backing sheet, such as a wire netting, to which the tiles are individually fastened by a cement of some kind. The cement is applied in a series of separated rows set back from the edges of the tiles. Ams teaches that "In this way the netting is exposed between the joints which * * * permits the facing to be readily rolled up * * *." (Col. 1, lines 47-52).

The Sisko patent, claim 1, does not exclude tiles by calling for a plurality of core blocks, and the backing sheet of the Ams patent is described as flexible. The wire netting of Ams is more "stretchable" than the fiberglass mesh of the accused product (Tr. 322). Hence, if the fiberglass of Southern Resin's accused Contourkore product is "stretchable" for purposes of infringement, then the wire mesh of the prior art Ams patent is "stretchable" in the same sense for purposes of invalidating Sisko's claims. It is axiomatic in the patent law that "that which infringes if later anticipates if earlier," Toch v. Zibell Damp Re-

sisting Paint Co., 233 Fed. 993, 994 (2 Cir. 1916). The connecting means (cement) of the Ams patent is applied in the manner called for by claim 1, and for the same purpose, to enable the product to be rolled up. The product patented by Sisko in his claim 1 is the same product as described by Ams, regardless of the use to which it may be put by purchasers of the product.

19. At most, the differences between the product defined in claims 1 to 4 of the patent in suit and the acknowledged prior art practice in using balsa wood as core material comes down to structural details, such as the use of nylon mesh instead of a cotton scrim cloth, and the use of spot gluing. Merely because something is new and useful is not a sufficient reason for saying that it is patentable. This has been true for more than a hundred years, Hotchkiss, et al. v. Greenwood, et al., 11 How. [52 U S.] 248, 266, (1850). This has been uniform law over the years, Sinclair Co. v. Interchemical Corp., 325 U.S. 327, 330 (1945) and is true today. Stabler v. Bright Leaf Industries, Inc., 261 F.2d 383, 385 (5 Cir. 1958 ; Spray-Bilt, Inc. v. Ingersoll-Rand World Trade, Limited, 350 F.2d 99, 103 (5 Cir. 1965).

20. As the shape of hulls of plastic boats changed over the years, it was perfectly normal for any skilled mechanic to find ways of binding blocks of balsa wood together to make them more and more flexible. While the patent does not teach this, it is perfectly obvious to anyone that the most important single factor in making a balsa wood block carpet that will readily conform to a compound curvature is to make the blocks small enough in size. The smaller they are, the more readily they will conform.

21. It is a principle of patent law that patents on combinations of old elements must be scrutinized especially carefully as to their ability to perform some new and very unusual and surprising function, A. & P. Tea Co. v. Supermarket Corp., 340 U.S. 147, 150-153 (1950); Aircraftsmen, Inc. v. Aircraft Equipment Co., ... F. Supp. . . . ; 147 U.S.P.Q. 267, 270 (S.D. Fla., Oct. 29, 1965).

22. Plaintiff, at the trial, alleged that the Sisko patent produced a new result or function—"drapability"—that is, it would conform to compound curved surfaces. But there was nothing new or surprising about this result or function. All that was required to give "drapability" was to make the blocks small enough individually, and to attach them to the fabric backing so that they had some freedom of motion relative to each other. The products of the Ams and Cunninghame patents had "drapability."

23. The prior art, including the Cunninghame and Ams patents and the prior practices of boat builders in using balsa core materials, were not before, or considered by, the Patent Office at the time they allowed the Sisko patent in suit, and are all much more pertinent than any of the prior art cited by the Patent Office during the prosecution of the Sisko patent. The claims of the Sisko patent fail to define any feature or structure that differs in any substantial or material respects from the products described in the Cunninghame and Ams patents, or from the balsa core materials used commercially in the prior art.

24. The minor differences which exist between the subject matter of the claims of the Sisko patent and the prior art are such that the subject matter as a

whole would have been obvious, at the time the alleged invention was made, to a person having ordinary skill in the art to which said subject matter pertains.

Conclusions of Law.

I. The Court has jurisdiction of the parties and over the subject matter of this action and defendant's counterclaim (28 U.S.C. §1338(a), §2201).

II. The Sisko patent No. 3,139,371 issued to plaintiff on June 30, 1964, and has been owned by plaintiff continuously since that date.

III. The Sisko patent is entitled to no presumption of validity over the prior art relied on by defendant, which was not cited or considered by the Patent Office.

IV. Claims 1 to 6, inclusive, of the Sisko patent are each invalid and void for lack of any patentable novelty over:

(a) Cunninghame patent 972,754;

(b) Ams patent 476,354, and;

(c) Certain prior practices of boat manufacturers in using balsa core materials in the manufacture of plastic boats.

V. Claims 1 and 2 of the Sisko patent are each invalid and void, as being anticipated by:

(a) Cunninghame patent 972,754, and;

(b) Ams patent 476,354.

VI. Claims 1 to 6, inclusive, of the Sisko patent are each invalid and void by reason of plaintiff's sale, more than one year before the filing date of the patent, of balsa core materials identical or substantially identical to the product claimed in claims 1 to 4 inclusive, of the Sisko patent, and the incorporation of such products, as specified by claims 5 and 6, into plastic boats, by plaintiff's customer, the Bertram Yacht Company, prior to May 24, 1962.

VII. Claims 1 to 6, inclusive, of the Sisko patent are each invalid and void for lack of any patentable invention over the prior art, because they define merely an obvious combination of components that were individually old and well-known for this purpose. The combination of these old elements produced no new or unexpected results, and would have been obvious to one skilled in the art at the time the alleged invention was made.

VIII. During the Patent Office prosecution of the Sisko patent application, each of the claims was limited to a "stretchable" backing material, and to connection of the backing material to the blocks at points spaced inwardly with respect to the side edges of the blocks. These limitations were placed in the claims in order to induce the Patent Office to allow the claims. Plaintiff cannot now recapture what he voluntarily gave up in the Patent Office, in order to induce the Examiner to allow his patent. As the accused product sold by the defendant does not incorporate a "stretchable" backing, and the product now sold by defendant additionally does not incorporate a connection of the backing material spaced inwardly from the side edges of the blocks, defendant has not infringed any of the claims of the Sisko patent.

IX. The defendant, Southern Resin & Fiberglass Corporation, is entitled to judgment against the plaintiff, John M. Sisko, dismissing the complaint with prejudice, and adjudging claims 1 to 6, inclusive, of Sisko patent 3,139,371 invalid and not infringed, and with taxable costs to defendant.

Judgment.

In accordance with the foregoing Findings of Fact and Conclusions of Law, it is hereby

Ordered, Adjudged and Decreed that

(1) Claims 1 to 6, inclusive, of United States Letters Patent No. 3,139,371 are, and each of them is, invalid and void in law.

(2) Claims 1 to 6, inclusive, of United States Letters Patent No. 3,139,371 have not been infringed by defendant.

(3) Plaintiff's complaint for infringment of said Letters Patent is hereby dismissed with prejudice, and plaintiff shall take nothing by his complaint.

(4) Defendant, Southern Resin & Fiberglass Corporation, shall have and recover from plaintiff, John M. Sisko, the taxable costs in this Court.

Done and Ordered at Miami, Florida, this 17th day of December, 1965.

W. O. MEHRTENS,
United States District Judge.

June 30, 1964 J. M. SISKO 3,139,371

CORE BLOCK CONSTRUCTION

Filed May 24, 1963

Fig. 1.

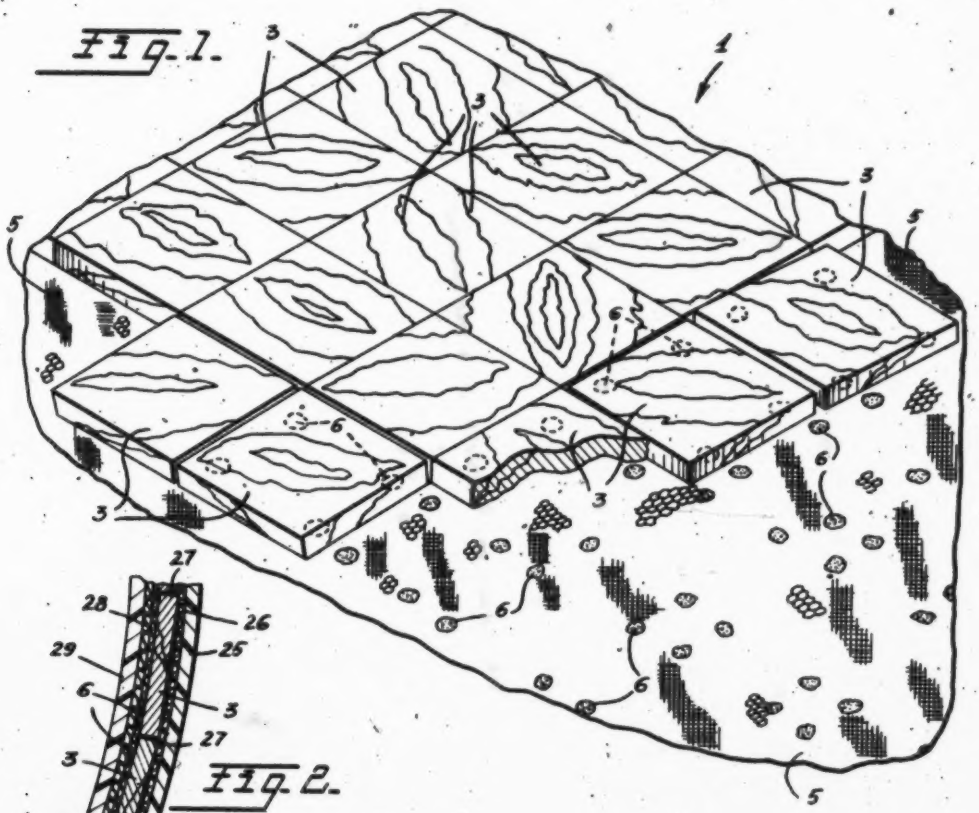


Fig. 2.

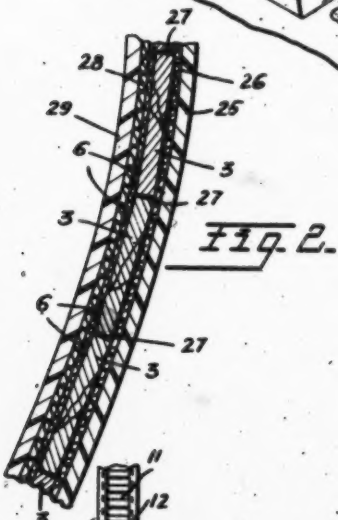
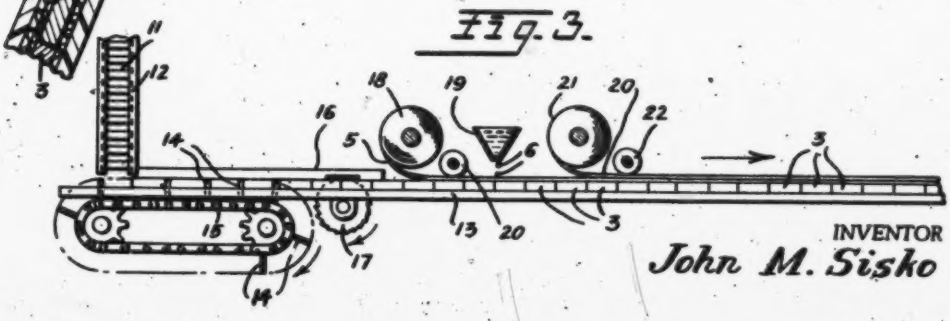


Fig. 3.



INVENTOR

John M. Sisko

BY

Baum & Thomas

ATTORNEYS

SUPREME COURT, U. S.

JUL 6 1967

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER 1967

No. 222

JOHN M. SISKO,

Petitioner,

v.

SOUTHERN RESIN & FIBERGLASS CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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TABLE OF AUTHORITIES

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There are no special or important reasons why the writ prayed for should be granted.

The decisions of the Court of Appeals for the Fifth Circuit and of the District Court both held the patent in suit invalid for the same reason. There is no conflict between decisions of Courts of Appeals or between the decisions of the two Courts below. No question of public importance is presented. Petitioner does not even present a question of law, but merely factual arguments based on alleged facts that are contrary to the findings of the District Court.

Opinions Below

The opinion of the Court of Appeals for the Fifth Circuit is reported at 373 F. 2d 866.

The findings and conclusions of the District Court are reported at 248 F. Supp. 797.

The District Court held the patent invalid on several grounds and also no infringement because of a file wrapper estoppel. The Court of Appeals affirmed on invalidity and said it was unnecessary to pass on the other issues.

These opinions appear in Petitioner's Appendix at App.* 3-11 and 13-28, respectively.

Jurisdiction

Jurisdictional requisites are set forth in the Petition.

Question Presented

Petitioner's "Question Presented" raises no issue for review by this Court. Instead, Petitioner merely argues that the holding of obviousness based on factual inquiries, as to which both Courts below are in agreement, "must be in error".

Petitioner's fact allegations (a) to (h) (p. 3) on which the "Question Presented" is based are argumentative and, in large part, contrary to the evidence and findings of the District Court. For example, the patented structure was not "a radical departure from the prior art", but amounted only to differences in structural details in an otherwise old combination (Findings 14, 15, 19 and 20; App. 22, 24). Petitioner's references to industry acceptance as shown by Respondent's "own survey," to the manufacturing of a "direct copy of the invention," to the "infringing product" that enjoyed commercial success, and the "advertising and promotion of the infringing product" by the "infringer" are wholly erroneous and directly contrary to the findings of the Courts below. These fact arguments of Petitioner are based on the erroneous assumption that the accused products were a copy of the patented article and an infringe-

* The pages of the Appendix to the Petition will be referred to hereafter as "App." followed by the page numbers.

ment of the patent. The District Court's Findings 5, 7 and 8 (App. 16-19) are just the opposite and are fully supported by the evidence.

Statement of the Case

Sisko, the Petitioner and patentee, did not originate the system of using balsa wood blocks as a reinforcing core material in plastic boat construction. As a balsa wood salesman in 1959 and 1960, he became familiar with the balsa wood blocks laid out in the form of sheets held together by an open mesh cotton scrim cloth glued to one surface of the blocks for use as cores in the manufacture of plastic boats (R 228-34, 281-2, 352). This system was part of the prior art and used in 1959 and 1960 by the Edwards Boat Company and Nortex Manufacturing Company (R 145-7, 156-7, 163-77, 229-34, DXs 4, 21 and 27). Petitioner's expert witness was also aware of this prior art practice (R 270-80).

The patent in suit (filed May 24, 1963) claims the same basic combination, balsa wood blocks held together in sheet form by a flexible, stretchable backing for use as a core material in making plastic boats. The differences claimed in the patent over this prior art are differences only in details, *viz.*, the use of smaller blocks, a nylon mesh cloth instead of a cotton scrim cloth and the use of spot gluing (Finding 19, App. 24; Ct. of Appeals Op., App. 10).

Petitioner used smaller blocks, the stretchable nylon mesh backing and the spot gluing features so that the assembly would conform more readily to curvatures used in the more modern hulls of plastic boats. The District Court found that as the shape of boat hulls changed over the years, any skilled mechanic could have found ways of binding the balsa wood blocks together to make them more flexible (Finding 20, App. 24).

The prior art also included two prior patents which had not been cited by the Patent Office during the prosecution

of the patent in suit, Ams patent 476,354 (DX 28) and Cunninghame patent 972,754 (DX 29).

Anything that was lacking in the flexibility or drapeability of the assemblies in the prior use of balsa blocks for making plastic boat hulls was clearly taught by the Ams and Cunninghame patents, also a part of the prior art. This is precisely what the District Court found (Findings 16-24, App. 22-26) and the Court of Appeals agreed (App. 8-11).

At most, the patent in suit claims an old combination with minor structural changes. Petitioner relies heavily upon commercial success which may very well have been as attributable to his past training as a salesman of balsa wood products as to any unusual merit of the patented product. In any event, as this Court said in *A & P Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, 153 (1950):

> "But commercial success without invention will not make patentability."

Petitioner argues a long-felt want in the industry for the patented product and quotes some charitable language from the Court of Appeals decision in this respect. There is no evidence that either the Edwards or Nortex Company in 1959 and 1960 was not completely satisfied with the balsa wood core materials they were then using in plastic boats. Petitioner, the patentee, testified that in 1961 and 1962 he could not have gotten the boat builders to test his products if he had given them away (R 310-11). This is hardly indicative of a long-felt need in the industry.

Thus, even Petitioner's fact arguments for a holding of nonobviousness do not stand up under a careful scrutiny of the record.

While the Court of Appeals did not find it necessary to pass on this issue, the District Court found as a fact that Petitioner, the patentee, had made repeated commercial sales of his patented product to Bertram Yacht Company in Miami more than one year before his filing date (Find-

ings 10-13, App. 19-21). Accordingly, the District Court held the patent in suit invalid on this additional ground (App. 27).

Reasons for Denying the Writ

Petitioner appears to assert (Petition, pp. 12-13)

(a) that this Court did not lay down sufficient guidelines for determining the issue of obviousness in *Graham* v. *John Deere Co.*, 383 U. S. 1 and *United States* v. *Adams*, 383 U. S. 39 (1966), and

(b) that the Courts below did not properly follow these decisions in deciding the patent here in suit to be invalid for obviousness.

As to the first point, this Court clearly recognized in *Graham* (pp. 17-19) that while the ultimate question of validity is a question of law, the determination of obviousness lends itself to several basic factual inquiries which this Court proceeded to point out and discuss.

Because of its very nature, the question of obviousness is essentially a determination or conclusion arrived at on the basis of a number of separate factual inquiries. Petitioner does not suggest, and we cannot imagine, how this Court could have laid down more explicit guidelines for this determination. Each case necessarily has to be decided on its own facts.

All the Petitioner has asserted is an argument of the facts of this case. There can be no doubt that the District Court applied the right standards and guidelines, even though the District Court's findings were made before the *Graham* and *Adams* decisions (see Findings 19-24, App. 24-6). The Court of Appeals decision likewise properly applied the test of *Graham* to the facts of this case (App. 7-11).

CONCLUSION

The Petition should be denied.

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SUPREME COURT, U. S.

JUL 25 1967

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 222

JOHN M. SISKO,
Petitioner,

v.

SOUTHERN RESIN &
FIBERGLASS CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

Respondent's Brief, filed July 6, 1967, challenges the primary basis for this Petition, arguing that the courts below had correctly applied the doctrines laid down by this Court in the *Graham* and *Adams* cases.[1] Petitioner submits that this position is predicated upon a completely erroneous interpretation of *Graham* and *Adams*, and upon an incomplete and misleading presentation of the facts under consideration here. Accordingly, this Brief is submitted under the provisions of Rule 24(4).

---

[1] *Graham v. John Deere, Co.*, 383 U.S. 1, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966); *United States v. Adams*, 383 U.S. 39, 15 L. ed. 2d 572, 86 S. Ct. 708 (1966).

Sisko Invention Is Closely Comparable to Adams Invention

Respondent alleges (Respondent's Brief, p. 5) that the Petition only asserts an argument of the facts in this case. And yet *Graham* and *Adams* demand this type of factual inquiry in applying the test of obviousness. Indeed the factual parallels between the Adams invention and the Sisko invention are so striking that they virtually preclude a holding of obviousness here.

Adams made the first successful water-activated, constant potential battery which could be stored indefinitely without fluid (L. ed. 2d 575). It was an important invention, recognized and adopted by the industry (L. ed. 2d 576). Similarly, Sisko made the first *unitary flexible core material for fiberglass laminates*, the first core material which would drape to adapt itself to compound curves. This was also important, recognized and adopted. Even the infringer, referring to its own infringing copy, called it "the most single greatest advancement in structural core materials in the last decade" (PX 140).

Sisko, like Adams, was an independent inventor who had worked with his own facilities for a period of years before he finally conceived his invention (383 U.S. 43). In both cases the inventors had found success only after long experimentation had finally led them to a solution, and in both cases the solution lay in a direction away from the prior art teachings (383 U.S. 45). Just as the Scrivanoff prior art in *Adams* had been a failure (383 U.S. 48), so too had the closest prior art (by Nortex and Edwards) in the fiberglass core field been a failure; and just as the Patent Office Examiner handling the Adams application had been unable to cite a single reference against the case (383 U.S. 52) so too the Examiner handling the Sisko application had failed to cite a single reference drawn from the field of flexible core materials.

As in *Adams* (383 U.S. 42), Sisko's invention was a simple but novel combination of three elements, all of which

were acknowledged to be old in and of themselves. But, as in *Adams* (383 U.S. 51), the Sisko invention performed a result that had never before been accomplished. There, as here, the key to success was "an interdependent functional relationship" of these elements (383 U.S. 50), and in both instances this was the basis upon which patentability was predicated.

Interestingly enough, in *Adams*, as here, an infringer with far greater resources, experience and expertise had been unable to come up with the solution which the industry had been seeking. There, as here, no alternative solution was found, and the infringer then proceeded in total disregard of the patentee's rights (383 U.S. 44).

In view of the foregoing, there is no basis for the Respondent to summarily dismiss (Respondent's Brief, p. 5) the Petitioner's contention that the *Adams* doctrine was not properly applied below.

Sisko's Invention Is Different in Kind From Graham and Calmar Inventions

Both patents which were invalidated by this Court in the *Graham* case related to minor improvements in devices that were old in the art, devices that had already been in use for the same purposes.

Graham had already received his '811 patent on a workable plow that had been put into use. In the '798 patent in suit, two minor mechanical changes had been made, with only marginal improvements in result or function being claimed. Even the petitioner's expert had minimized the effect of these changes (383 U.S. 24, Footnote 12).

Similarly in *Calmar*, the alleged invention was simply a case of putting a rib seal in a different position and preventing the overcap from contacting the container cap. No significant change in function resulted, i.e., the patented construction operated in the same general manner for the same general purposes as the prior art.

Thus, neither of these cases involves a situation like *Adams* or *Sisko* wherein the overall combination is new and wherein for the first time this combination achieves a result never before obtainable.

The Sisko Invention Meets the Tests Expounded in Graham

On the other hand, the *Graham* case specifically spells out the criteria of patentability upon which the Petitioner is relying in the present case. There the Court cited the importance of the basic factual inquiries into the scope and content of the prior art, the distinctions of the claimed invention, and the level of ordinary skill in the field. Here we have clear distinctions over the prior art, dramatic differences in result, and demonstrated facts as to the difficulties in achievement by the inventor and others in the field. Indeed, on the critical last point, it has been shown that the infringer had serious problems in copying the product even *after* he saw the patented product and knew how successful it was (PX 81-83). How then was this solution obvious?

In *Graham* the Court went on to specifically espouse an inquiry into such further factors as "commercial success, long felt but unsolved needs, failure of others, etc.". (383 U.S. 17) All of these factors have been abundantly demonstrated by the evidence in the present case, but their significance was ignored by the Court below.

The Need for Further Guidance Explained

Petitioner has argued (Petition, page 12) that the doctrine of obviousness requires further elucidation by this Court, and Respondent leaps to the conclusion (Respondent's Brief, page 5) that this argument implies some inadequacy in the *Graham* and *Adams* opinions. If this type of reasoning were followed, exception would have to be taken every Sunday with all sermons given on the Ten Commandments; but there, as here, no criticism of the draftsmanship is intended.

On the contrary, this Court's opinions in *Graham* and *Adams* were most clearly and thoughtfully expounded, and the issue of obviousness was treated in some depth. Nevertheless, the issue is of paramount importance to the patent law, and the Court should insure against any disregard or misinterpretation of the guidelines it has laid down. The facts of the pending case are clearcut. They lend themselves well to the type of factual inquiry which the Court has espoused, and they lead preponderantly to a holding contrary to that of the Court of Appeals below. Thus they provide an excellent opportunity to underscore and amplify the Court's philosophy on obviousness. This would be of great benefit to the courts below, to the patent profession, and to the patent system generally.

The *Graham* and *Adams* cases have been cited extensively in subsequent decisions, and the need for further guidance is clearly apparent from the many and varied interpretations that have resulted. One of the primary rules of law emphasized by this Court in *Graham* was the necessity of pursuing factual inquiries of the type here under consideration *before* determining the question of obviousness (383 U.S. 17) The Court stressed that the invention must be considered with reference to its position in the art and with reference to its functional and commercial impact. This emphasis could have had but one purpose: to deter the often acknowledged but still abused practice of simply making an unsupported subjective decision as to what is obvious and what is not. This very natural tendency has been the cause of conflicting standards of patentability as applied by the Patent Office and the various courts prior to *Graham*. The hazards involved in making such a purely subjective decision had been cited by Judge Learned Hand as follows:

> "To judge on our own that this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it." (*Reiner v. I. Leon Co.*, 285 F.2d 501 (C.A. 2, 1960)

Without such factual inquiry, the courts have been particularly prone to judge by hindsight and to unintentionally convert "simplicity into obviousness in the face of hard proof of recognized need for the answer, of long, unsuccessful search for the answer by people of skill in the art, of recognition by the industry that the claimed invention was the answer, and of its prompt adoption with attendant commercial success." *Allen v. Standard Crankshaft & Hydraulic Co.*, 323 F.2d 29 (C.A. 4, 1963)

There has been a disturbing tendency since the *Graham* decision for courts to recite the factual inquiries and then to ignore them completely in coming to a purely subjective decision, still citing *Graham* as authority. See, for example, the dissenting comments in *Application of Dailey*, 357 F.2d 669, 673-679 (CCPA, 1966). After a careful appraisal of relevant facts not properly understood by the majority, Judge Smith concluded:

> "While the majority has seen fit to pay lip service to the decision in Graham v. John Deere Co. of Kansas City, 86 S. Ct. 684, it is my opinion that it has ignored the fundamental rationale of the case which, as I view it, would prohibit the type of obviousness rejection which the majority here affirms." p. 677.

See also a similar dissent in the Fifth Circuit in the case of *Upright Inc. v. Safway Products, Inc.*, 364 F.2d 580 (C.A. 5, 1966), where Judge Marvin Jones concluded at p. 584:

> "The majority of this court, and the court below, although professing to be guided by the factual inquiries specified in Graham, in my judgment misapply these tests and thereby reach an erroneous legal conclusion."

In the following cases, each of which rely upon *Graham* for support, the results raise a serious question as to whether the respective courts have properly evaluated the effect of the *Graham* decision:

> *L and A Products, Inc. v. Britt Tech Corporation*, 365 F.2d 83 (C.A. 8, 1966); *Santa Anita Manufac-*

turing Corp. v. Lugash, 369 F.2d 964 (C.A. 9, 1966); and *Davis v. Mathews*, 361 F.2d 899 (C.A. 8, 1966).

In the latter case, for example, none of the prior art was held to resemble the invention or to anticipate any of its basic features. The invention apparently functioned in a novel manner and was a commercial success, and yet, in spite of extensive reference to the *Graham* decision, it would appear that the Court ignored all such relevant factual considerations and decided on the basis of its own personal subjective opinion of obviousness. This is the very type of reasoning which should have been precluded by this Court's ruling in the *Graham* case.

Critical Errors and Deficiencies in Respondent's Statement

There would be no possibility of accepting Respondent's substantive conclusions unless this Court were to make the drastic mistake of accepting at face value the Respondent's statement of the case. This abbreviated presentation is so incomplete, selective and inaccurate that it is entirely misleading.

Petitioner recognizes how easy it would be to start with the relatively simple nature of the invention, to then realize how plausible Respondent's presentation sounds, and then to accept the holding of obviousness below. For this reason Petitioner feels that the basic facts must be subjected to a more searching scrutiny than is normally necessitated in proceedings before this Court, and such enquiry is most earnestly solicited.

Addressing directly the Respondent's presentation, it is submitted that the prior art practices of Nortex and Edwards are misrepresented. At page 3 of the Brief, Respondent speaks of wood "blocks" which were "held together by" a backing cloth glued across one surface of the blocks. This description, as far as it goes, would appear to be a complete anticipation of the patented construction. What the description fails to acknowledge is that the "blocks" of Nortex and

Edwards were not truly held together by the backing sheet. On the contrary, the entire assembly was coated with a thick layer of resin which was allowed to harden in assembly stage. Thus, it was the resin itself, and *not* the backing sheet, which really held the elements together. More important, this resin made the completed assembly as stiff as a board, whereas the very purpose of the Petitioner's invention was to achieve a flexible core material.

The foregoing interpretation of the prior art is not mere speculation. It is clearly illustrated by the photograph PX-77 and is unequivocally established by the testimony of Jordan Pfuntner (R. 271-277) which stands undisputed and unrebutted in the record. If contrary proof were available, the infringer would have had it because the infringer had supplied both Nortex and Edwards. Against this record it is entirely misleading for the Respondent to remain silent on this very basic distinction over the prior art.

It should be noted that the Respondent merely acknowledges that the Petitioner uses smaller blocks than the prior art. In actual fact, the record clearly shows that the prior art constructions of Nortex and Edwards involved elongated slats rather than square blocks, and that these slats were arranged in a longitudinally staggered brick-type pattern rather than being in aligned, side-to-side, and end-to-end relationship (R. 271). This configuration and disposition of the prior art elements would in itself have precluded any significant flexing of the assembly. Thus, the prior art, even if it had not had a rigid resin coating, could not have adapted itself to compound curvatures of the type with which the Petitioner was concerned.

In trying to suggest that Edwards and Nortex might have been completely satisfied with their product, Respondent fails to acknowledge the evidence establishing that this was an unsatisfactory product (R. 271, 280). As to whether Edwards and Nortex were themselves satisfied, Petitioner would only note that both of them were quickly out of business (R. 166, 279).

In referring to the patented prior art, Respondent fails to acknowledge that Ams and Cunninghame contain no teachings that were not already of record in the prior patents cited by the Patent Office. Respondent also fails to acknowledge that these patents were drawn from the entirely non-analogous art of decorative wall coverings or the like. There is no suggestion in Respondent's presentation as to why a man skilled in the art of laminated core materials would look to the field of decorative wall coverings for guidance, and there is no indication of why he would take the further step of effecting the modifications necessary to adapt the Cunninghame and Ams constructions to this new use. The conclusion of obviousness is strictly a matter of hindsight and this is clearly demonstrated by the facts: by the inventor's long and arduous development work, by the failure of the infringer's previous efforts to develop a satisfactory product of this type, and by the frantic and unsuccessful efforts of the infringer to develop a competing product that did not infringe. These facts are all clearly of record and must be recognized before the invention can be viewed in the proper context.

Finally, Petitioner would note that the issue of public use, referred to on page four of Respondent's Brief, is not in issue here.

SUMMARY

For the foregoing reasons, Petitioner renews his application for this Honorable Court to grant certiorari in this matter.

Respectfully submitted,

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